

**REMARKS****I. Summary**

Claims 1 – 8, 10 – 23, and 25 – 30 are pending in the application. Claims 9 and 24 are cancelled. Claim 12 is objected to as being dependent from a rejected base claim but would be allowable if rewritten in independent form. The following are the outstanding issues in the instant application:

- Claim 22 stands rejected under 35 U.S.C. § 112 as being indefinite for failing to point out and distinctly claim the subject matter.
- Claims 1 – 8, 11, 13 – 18, 20 and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 6,018,720 issued to Fujimoto (hereinafter Fujimoto).
- Claims 10 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujimoto.
- Claims 1 – 8, 10 – 11, 13, 22, 23 and 25 – 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. issued to Smith et al. (hereinafter Smith) in view of Fujimoto.

Applicants traverse the current rejections and request reconsideration and withdrawal of the rejections in light of the remarks contained herein.

**II. Rejection under 35 U.S.C. § 112**

Further to Examiner's comments, Applicants have amended claim 22 to read "said medium" instead of "a medium." This amendment does not alter the scope of the claim and does not enter any new matter.

### III. Rejections under 35 U.S.C. § 102(b)

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

#### A. The Independent Claims

##### 1. Claim 1

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Fujimoto. Claim 1 recites, in part, “recording a unique identification number assigned to each medium in at least a portion of a data library.” Examiner cites to Fujimoto, col. 13, lines 19 – 25 as teaching this limitation of claim 1. Office Action, page 3. However, the cited portion of Fujimoto does not teach that each medium is in at least a portion of a data library. Rather, Fujimoto teaches about a purchaser’s rewritable record medium, which stores data including purchased software and purchaser’s purchase data. Col. 2, lines 52 – 55. In fact, Fujimoto’s rewritable medium is sold individually and thus could not be a part of a data library. *See* Abstract (stating, “[a] purchaser purchases a purchaser record medium, to which game software is rewritten or reloaded, at a shop.”) Thus, Examiner has not shown Fujimoto teaches “each medium in at least a portion of a data library,” as recited in claim 1.

Additionally, claim 1 recites, “commanding at least one selected data transfer element in said library to only accept media having particular ones of said identification numbers.” Examiner asserts that this limitation is equivalent to Fujimoto judging “that the purchaser’s identification inherent data/accounting data recorded in the purchaser record medium 13 is normal or matched with purchaser’s ID stored in computers 21 – 23, the record medium 13 is accepted for processing in computer 24.” Office Action, page 3. Applicant respectfully disagrees that the cited portion of Fujimoto teaches the limitations of claim 1, as set out by the Examiner.

In claim 1, the at least one selected data transfer element is commanded to only accept media with particular ones of the identification numbers. This is clearly different than the operation of the system in Fujimoto. In Fujimoto the data transfer element reads the data cited by the Examiner and then sends that data to computer system remote from the data transfer element to determine whether the data read from the rewritable disk agrees with data stored on the remote computer system. The information about which disks to accept is not sent to the data transfer element, but rather the data transfer element of Fujimoto sends data for evaluation to a remote computer system. It is only after this remote evaluation process occurs that the data transfer element is instructed whether to eject the record medium or not. *See* col. 13, lines 19 – 47; Fig. 1.

In sum, Fujimoto, as cited by Examiner, does not teach media in a portion of a data library, nor commanding a data transfer element to only accept media having particular ones of identification numbers as required by claim 1 and, therefore, does not anticipate claim 1. Accordingly, Applicants respectfully request that Examiner withdraw the rejection to claim 1 under 35 U.S.C. § 102(b).

## 2. Claim 14

Claim 14 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Fujimoto. Claim 14 requires listing identification numbers of media that data transfer elements in a partition of a partitioned data library are allowed to access in memory storage of data transfer elements in the partition. Examiner asserts that this limitation of claim 14 is equivalent to “the purchaser’s ID including the purchaser’s inherent data/accounting data are listed and stored in computers 21 – 23 [in Fujimoto].” Office Action, page 5. Examiner cites to col. 13, lines 27 – 29 in support of this assertion.

The Examiner has not shown that Fujimoto teaches a partitioned data library as required by claim 14. Second, Examiner has not shown the listing of identification numbers “in memory storage of said data transfer elements.” Rather, Examiner states, “the purchaser’s ID including the purchaser’s inherent data/accounting data are listed and stored in computers 21 – 23 [in Fujimoto].” *Id.* Examiner equates the purchaser’s inherent data/accounting data with the

identification number and therefore Examiner's asserted identification numbers are not stored in the memory of Fujimoto's data transfer element, but rather, the Examiner recognizes that the asserted identification number is stored in remote computers 21 – 23. Therefore, Examiner has failed to show Fujimoto teaches the limitation, "listing identification numbers of media that data transfer elements in said partition are allowed to access in memory storage of said data transfer elements in said partition."

Claim 14 also recites, "checking said memory storage of a data transfer element receiving said selected medium for said identification number of said selected medium." Examiner asserts this limitation of claim 14 is equivalent to Fujimoto's "checking whether the purchaser's ID is matched or unmatched." Office Action, page 5 – 6. Because there is no storage of identification numbers in the memory storage of the data transfer element in Fujimoto, then Fujimoto cannot teach checking for identification numbers in the memory storage of a data transfer element. Thus, the cited portion of Fujimoto fails to teach, "checking said memory storage of a data transfer element receiving said selected medium for said identification number of said selected medium," as recited in claim 14.

Claim 14 also recites, "accessing said selected medium in response to said identification number of said selected medium being present in said memory storage of said data transfer element receiving said selected medium." As discussed above, because no identification numbers are stored in the memory of Fujimoto's data transfer element, then Fujimoto does not teach "response to said identification number ... being present in said memory storage of said data transfer element ...," as recited in claim 14.

Furthermore, no accessing of the purchaser's record medium occurs if the Fujimoto collation process returns a match. Rather, it is the software being sold from the Software deliverer's computer that is being accessed for download to the purchaser's record medium. Col. 13, lines 49 – 53. Therefore, Examiner has not shown Fujimoto teaches, "accessing said selected medium in response to said identification number of said selected medium being present in said memory storage of said data transfer element receiving said selected medium," as recited in claim 14.

In sum, Fujimoto, as cited by Examiner, does not teach all the limitations of claim 14 and, therefore, does not anticipate claim 14. Accordingly, Applicants respectfully request that Examiner withdraw the rejection to claim 14 under 35 U.S.C. § 102(b).

B. The Dependent Claims

Claims 2 – 8, 11 and 13 depend from base claim 1. Claims 15 – 18, 20 and 21 depend from base claim 14. Each of these dependent claims inherit the limitations of their respective base claims and at least for this reason are patentable. Accordingly, Applicants respectfully request that Examiner withdraw the rejections of claims 2 – 8, 11, 13, 15 – 18, 20 and 21 under 35 U.S.C. § 102(b).

IV. Rejections under 35 U.S.C. § 103(a) (Smith in view of Fujimoto)

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. M.P.E.P. § 2142; *In re Peehs*, 612 F.2d 1287, 204 U.S.P.Q. 835, 837 (C.C.P.A. 1980). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). For each rejected claim, Examiner fails to satisfy, at least, the requirements that (1) the applied art teaches all claim limitations and (2) that there is proper motivation for one of ordinary skill in the art to make the asserted combination.

A. The Independent Claims

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Fujimoto. Claim 1 recites, in part, “commanding at least one selected data transfer

element in said library to only accept media having particular ones of said identification numbers.” As the Examiner admits, Smith does not describe at least this limitation.

Smith describes a cabinet and carrier for storing and retrieving articles, such as magnetic tape drives. Abstract. Each article has an associated identifier, the “VOLSER” number, which is used by the retrieval mechanism to identify the contents of the storage locations in the cabinet. Id. A host computer controls the operation of the system, but no central database is maintained of the coded articles, instead the identifiers are stored in respective memories associated with each article. Id.

The mechanism of Smith is described further with reference to Figures 14A and 14B. When a tape request command is received by the system, the VOLSER number is read into the RAM of the microcontroller. Column 24, lines 39-41. The VOLSER number stored in RAM is then compared against the VOLSER numbers of the tape cartridges by sequentially reading the VOLSER numbers from the respective EEPROM memories thereof. Col. 24, lines 44-50.

In attempting to show that the claim is obvious over the art of record, the Examiner asserts that “by determining the location of the requested medium (tape) with respect to matching VOLSER numbers, it’s clearly understood that any transfer element within Smith’s system must only accept media associated with the matching VOLSER number to avoid transferring any unmatched media or unmatched media data to the host.” Office Action at page 4. However, it is a fundamental concept of Smith that, by identifying the tape by the VOLSER number stored in the EEPROM memory affixed to the tape cartridge, only the media associated with the matching VOLSER number will be selected for use with the transfer element. *See e.g.*, col. 26, lines 54-59. Accordingly, tape cartridges that do not have a matching VOLSER number are never sent to the transfer device and cannot therefore be rejected. Column 24, lines 57-61. One of ordinary skill in the art would not have been led to modify the system of Smith to command a data transfer element to only accept media having particular ones of the VOLSER numbers because Smith teaches that only the tape having the proper VOLSER number will be selected for use with the data transfer element.

In proffering a statement of motivation with respect to the foregoing modification to Smith, the Examiner asserts that “it would have been obvious to one having ordinary skill in the art at the time the current invention was made to implement the data transfer element in the library to only accept media having matching VOLSER number or matching identification number as being claimed [because] it would enhance system reliability; reducing data transferring error by avoiding reading wrong data in any unmatched media, therefore being advantageous.” Office Action at pages 4 and 5. The Examiner has not provided an objective reason to combine the teachings of the references. *See* M.P.E.P. 2142.01. The reason provided by the Examiner—i.e., “to enhance system reliability,” is a general incentive, and not an objective reason. Applicant points out that “[a] general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out.” *In re Deuel*, 51 F.3d 1552, 1559 (Fed. Cir. 1995). Therefore, the motivation provided by the Examiner for modifying Smith is improper.

Moreover, the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness. M.P.E.P. § 2143.01. The language of the recited motivation is circular in nature, stating that it is obvious to make the modification (command a data transfer element to only accept media having particular identification numbers) because it is obvious to achieve the result (avoid reading wrong data from media not having particular identification numbers). Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680, (Fed. Cir. 1990)). Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

Additionally, Applicant respectfully submits that the Examiner’s proposed modification of Smith would require substantial unsuggested modification to meet the claim. The only information that Smith operates on is a VOLSER number in a tape request command. Having only this information in the microcontroller, the system as shown and described in Smith cannot do anything other than determine if the requested tape exists, find its location and deliver it to the

transfer device. Smith has no means to determine the propriety of the VOLSER number associated with a tape cartridge provided to a transfer element. Without any other structure, which Smith explicitly states does not exist (see, Abstract), Smith cannot be modified to command a data transfer element, to only accept media associated with a set of identification numbers as the Examiner's attempted modification requires. As the Examiner's proposed modification is improper given the explicit teachings of Smith, Applicant respectfully asserts that claim 1 is allowable over the rejection of record.

Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Fujimoto. Claim 22 recites, in part, "a plurality of data transfer elements that are adapted to receive said media and transfer data to and from said media, . . . wherein access to said media by each of said data transfer elements is restricted to media having particular ones of said identification numbers." Again, the Examiner admits that Smith does not disclose that access to the media by each of the data transfer elements is restricted to media having particular ones of the identification numbers. Office Action at page 8. As with claim 1, the Examiner attempts to show that the claim is obvious over the art of record, by asserting that "by determining the location of the requested medium (tape) with respect to matching VOLSER numbers, it's clearly understood that any transfer element within Smith's system must only accept media associated with the matching VOLSER number to avoid transferring any unmatched media or unmatched media data to the host." Office Action at pages 8-9.

As described above, however, it is a fundamental concept of Smith that only the media associated with the matching VOLSER number will be selected for use with the transfer element, and therefore, tape cartridges that do not have a matching VOLSER number are never sent to the transfer device and cannot therefore access to the data transfer elements would never need to be restricted. *See e.g.*, col. 26, lines 54-59 and column 24, lines 57-61. One of ordinary skill in the art would not have been led to modify the system of Smith to restrict access to said media by each of said data transfer elements to media having particular ones of said identification numbers because Smith teaches that tapes are only retrieved in response to tape request command and only the tape having the VOLSER number contained in the tape request command will be selected for use with the data transfer element. Smith never discloses any type



of vetting of tape request commands, only the reading of the associated VOLSER number and searching the EEPROM devices for a match.

Again, the Examiner's stated motivation with respect to the foregoing modification to Smith is that "it would have been obvious to one having ordinary skill in the art at the time the current invention was made to implement the data transfer element in the library to only accept media having matching VOLSER number or matching identification number as being claimed [because] it would enhance system reliability; reducing data transferring error by avoiding reading wrong data in any unmatched media, therefore being advantageous." Office Action at page 9. This is not an objective reason to combine the teachings of the references as required under M.P.E.P. 2142.01 but rather a general incentive. *See, In re Deuel*. Therefore, the motivation provided by the Examiner for modifying Smith is improper.

As with claim 1, the Examiner's proposed modification of Smith would require substantial unsuggested modification to meet the claim. Without any other structure, which Smith explicitly states does not exist (see, Abstract), Smith cannot be modified to restrict access to said media by each of said data transfer elements to media having particular ones of said identification numbers as the Examiner's attempted modification requires. As the Examiner's proposed modification is improper given the explicit teachings of Smith, Applicant respectfully asserts that claim 22 is allowable over the rejection of record.

In sum, Examiner has not shown that the applied art teaches all the limitations of claims 1 and 22 or that there is proper motivation or suggestion to modify Smith as asserted by Examiner. Therefore, Examiner has failed to establish a prima facie case of obviousness under 35 U.S.C. § 103(a). Accordingly, Applicant respectfully requests that Examiner withdraw the rejections of claims 1 and 22 under 35 U.S.C. § 103(a).

#### B. The Dependent Claims

Claims 2 – 8, 10, 11 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Fujimoto. Claims 2 – 8, 10, 11 and 13 depend from claim 1 and therefore inherit the limitations of claim 1. As discussed above, Smith and Fujimoto,

individually or in combination, do not teach the limitations “recording a unique identification number ... in at least a portion of a data library” and “commanding ...data transfer element ...to only accept media having particular ones of said identification numbers; and ejecting a medium ... in response to said identification number not being one of said particular ones of said identification number” as recited in claim 1. Because claims 2 – 8, 10, 11 and 13 inherit these limitations of claim 1, claims 2 – 8, 10, 11 and 13 are patentable. Accordingly, Applicants respectfully request that Examiner withdraw the rejections to claims 2 – 8, 10, 11 and 13 under 35 U.S.C. § 103(a).

Claims 23 and 25 – 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Fujimoto. Claims 23 and 25 – 30 depend from claim 22 and therefore inherit the limitations of claim 22. Claim 22 recites, in part, “a plurality of data transfer elements that are adapted to receive said media and transfer data to and from said media” and “access to said media by each of said data transfer elements is restricted to media having particular ones of said identification numbers.” As discussed above, Smith and Fujimoto, individually or in combination, do not teach these limitations of claim 22. Claims 23 and 25 – 30 inherit the limitations of claim 22. Therefore, claims 23 and 25 – 30 are patentable over Smith in view of Fujimoto. Accordingly, Applicants respectfully request that Examiner withdraw the rejections to claims 23 and 25 – 30 under 35 U.S.C. § 103(a).

#### V. Rejections under 35 U.S.C. § 103(a) (Smith)

Claims 10 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujimoto. Claims 10 and 19 depend from claims 1 and 14 respectively. Claims 10 and 19 inherit the limitations of their respective base claims. As discussed above, Fujimoto does not teach all the limitations of claims 1 or 14 and least for this reason are patentable. Accordingly, Applicants respectfully request that Examiner withdraw the rejections to claims 10 and 19 under 35 U.S.C. § 103(a).

VI. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 30014514-1 from which the undersigned is authorized to draw.

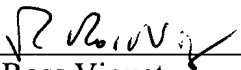
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